25. The pocket-size personal check encoder, as set forth in claim 19, wherein the check encoder is operable to print the check amount alphabetically in an alphabetical amount field and numerically in a numerical amount field on the check.

26. The pocket-size personal check encoder, as set forth in claim 19, wherein the check is a blank check.

REMARKS

This application has been carefully reviewed in light of the Official Action mailed May 29, 1998. To advance the prosecution of the application, claim 1 has been amended. Claims 1-26 remain in the application.

Claims 1-5 directed toward an automated system for encoding on the face of a check at a point-of-sale were rejected under 35 U.S.C. § 102(b) over Duck. This rejection is respectfully traversed. In order to properly reject the claims under 35 U.S.C. § 102(b) over a certain reference, that reference has to show or disclose each and every limitation in the claim.

Nowhere does Duck teach or suggest a system set forth in amended claim 1, which includes, but is not limited to, features described by highlighted text:

> 1. An automated system for ***encoding on the face of a check*** at a point-of-sale, comprising:
>
> a point-of-sale register operable to determine a transaction amount;
>
> an input device coupled to the point-of-sale register and operable to receive the transaction amount and determine a check amount in response to receiving an input from a user; and
>
> a check encoder coupled to the point-of-sale register and the input device and operable to receive the check amount and ***encode the check amount in a machine-readable format at a predetermined location on the face of the check*** (emphasis added).

Duck discloses a system in which ***labels*** are printed. Duck discloses, "[t]his system employs a printer ***which prints onto labels*** the critical areas of the check or negotiable instrument, such as: tendered amount, payee, and date. ***The labels are then removed and permanently applied to the***

check. . . ." (column 2, lines 39-44; emphasis added). Amended claim 1 prints the check amount ***directly on the face of the check***. Therefore a user using Duck's device would have to print the labels, remove the labels from the adhesive backing and then stick these labels, one by one, onto the check in the correct locations.

Furthermore, claim 1 teaches the printing of the check amount in a ***machine-readable format***. More specifically, this check amount printed in machine-readable format is printed in ***magnetic ink*** at ***a predetermined location on the face of the check***. This predetermined location is typically on the MICR (magnetic ink character recognition) line located at the bottom of the check. These limitations are generally set forth on page 8 of the specification. Because Duck does not include these limitations, the check processing disadvantages and inefficiencies discussed in the specification of the present application is not avoided. Accordingly, claim 1 is clearly patentable over Duck.

Claims 2-5 depend from amended and allowable claim 1 and were similarly rejected over Duck. These dependent claims are also allowable over Duck for the same reasons as set forth above. In particular, claim 2 is directed to "***a magnetic ink encoder*** operable to encode the check amount in magnetic ink at a predetermined location on the check." (Emphasis added) Duck does not disclose or suggest this limitation either in structure or function. Therefore, claim 2 is also patentable over Duck. Dependent claim 3 includes additionally "a keypad having a plurality of numeric and function keys." Duck does not show or suggest this limitation. Therefore, claim 3 is allowable. Dependent claim 4 includes "a display operable to display a preview of information to be printed and encoded on the check," which is also not disclosed or suggested by Duck. Dependent claim 5 specifies that "the check is a blank check." This is not required by Duck, as the user may paste the printed labels over fields already written in. It may be seen from the foregoing that the only conclusion that can be drawn from this discussion is that claims 1 and claims 2-5 depending therefrom are patentably distinct over Duck.

Claims 6-12 directed toward a method for encoding checks at a point-of-sale were also rejected under 35 U.S.C. § 102(b) over Duck. This rejection is respectfully traversed. Method claim 6 includes:

determining a transaction amount;

receiving an input from a user in response to the transaction amount and determining a check amount;

receiving a check;

encoding the check amount on the face of the check in a ***machine-readable format*** at a ***predetermined location***; and

issuing the encoded check. (emphasis added)

Duck does not show each and every one of these steps. For example, Duck does not show receiving a ***user input*** in response to the transaction amount and then ***determining a check amount***, so that the check amount may be more or less than the transaction amount. Duck also does not show the step of ***receiving a check***. Further, Duck does not show ***encoding the check amount on the face of the check***. Moreover, Duck also does not show the encoding being done in a ***machine-readable format***. What's more, Duck also does not show encoding on the face of the check ***at a predetermined location***. It may be easily seen from the foregoing that claim 6 is patentable over Duck.

Claims 7-12 depend from claim 6 and are also patentable for the same reasons. Claim 7 provides for ***printing a payee name on the face of the check***. This is lacking in Duck. Claim 8 provides for "***printing a payee name*** at a ***predetermined payee location on the check***; ***printing a numeric check amount*** at a ***predetermined check amount numeric location on the check***; and ***printing the check amount in words*** at a ***predetermined check amount word location on the check***." Duck does not show or suggest any of these method steps, as Duck provides for printing labels which are then affixed to the check. Claim 9 further provides for "displaying a transaction amount; and ***receiving a confirmation*** of the transaction amount as the check amount or ***receiving a check amount*** input from the user which overrides the transaction amount." This is not shown or suggested by Duck. Claim 10 further provides for the step of "***receiving*** a blank check." Duck does not do this as Duck does not print directly on the check. Claim 11 further calls for "*printing the check amount in a magnetic ink* at the ***predetermined location on the check***." Finally, claim 12 provides for "printing the check amount in a ***magnetic ink*** on a ***MICR line of the check***." Clearly, Duck neither disclose nor suggest these limitations as set forth in claims 6-12. Accordingly, claim 6 and claims 7-12 depending therefrom are patentable over Duck.

Claims 13-18 directed toward a method for encoding checks at a point-of-sale were also rejected under 35 U.S.C. § 102(b) over Duck. This rejection is respectfully traversed. Method claim 13 includes:

> determining a transaction amount;
> receiving an input from a user in response to the transaction amount and ***determining a check amount***;
> ***receiving a check***;
> ***printing a payee name at a predetermined payee location on the check***;
> ***printing a numeric check amount on a predetermined numeric check amount location on the check***;
> ***printing the check amount in words on a predetermined word check amount location on the check***;
> ***encoding the check amount on the face of the blank check in magnetic ink on a MICR line of the check***; and
> issuing the encoded check to the user. (Emphasis added)

It is easily seen that Duck lacks many of the limitations set forth in claim 13. Therefore, claim 13 is patentable over Duck.

Claims 14-18 depend from patentable claim 13 and includes many more limitations not found in Duck. Claim 14 provides for "receiving a confirmation that the transaction amount is the check amount." Claim 15 provides for "receiving the check amount which is not equal to the transaction amount." Claim 16 provides for "displaying the payee name and check amount prior to printing and encoding the check." Claim 17 provides for "displaying the payee name and transaction amount after receiving the transaction amount; and displaying the payee name and check amount after receiving user input." Claim 18 provides for "receiving a blank check." Duck neither discloses nor suggests these limitations. Accordingly, claims 14-18 area also patentable.

Claims 19-26 directed toward a ***pocket-size personal check encoder*** were also rejected under 35 U.S.C. § 102(b) over Duck. This rejection is respectfully traversed. Claim 19 cites,

> a ***keypad*** having a plurality of alphanumeric keys operable to receive a check amount from a user;
> a ***display*** coupled to the keypad and operable to display the check amount entered by the user; and
> a ***check encoder*** coupled to the keypad and display operable to receive the check amount from the keypad and encode the check amount in a

machine-readable format at a ***predetermined location on a check***. (Emphasis added)

Duck does not disclose or suggest these limitations. Duck merely shows a label printer located at a point-of-sale. Accordingly, claim 19 is patentable over Duck.

Dependent claims 20-26 were also rejected over Duck. Claim 20 includes "a memory coupled to the check encoder operable to store and recall a list of payee names." Claim 21 includes "a magnet ink encoder operable to encode the check amount in magnetic ink at this predetermined location on the check." Claim 22 provides that "the magnetic ink encoder is operable to encode the check amount in magnetic ink on a MICR line at the bottom right of the check." Claim 23 provides that "the display is operable to display the list of recalled payee names and the keypad is operable to receive a payee selection input from the user." Claim 24 provides that "the check encoder is operable to print a selected payee name in a payee field on the check." Claim 25 provides that "the check encoder is operable to print the check amount alphabetically in an alphabetical amount field and numerically in a numerical amount field on the check." Claim 26 provides that "the check is a blank check." It may be seen that Duck lacks most if not all of these limitations set forth in claims 20-26. Thus, claims 20-26 are also patentable over Duck.

CONCLUSION

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons and for other reasons clearly apparent, Applicant respectfully requests reconsideration and full allowance of all pending claims.

If the Examiner believes a telephone conference would advance prosecution of this case, the undersigned attorney for Applicant stands willing to conduct such a telephone interview at the convenience of the Examiner.

Applicant does not believe that any additional fees are due; however, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 05-0765 of Electronic Data Systems Corporation.

Respectfully submitted,
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